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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,906	03/23/2004	Jeffrey H. Burbank	53951-124	3978

21890 7590 01/24/2007  
PROSKAUER ROSE LLP  
PATENT DEPARTMENT  
1585 BROADWAY  
NEW YORK, NY 10036-8299

EXAMINER
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DEAK, LESLIE R

ART UNIT	PAPER NUMBER
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3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

NT

<b>Office Action Summary</b>	<b>Application No.</b> 10/807,906	<b>Applicant(s)</b> BURBANK ET AL.	
	<b>Examiner</b> Leslie R. Deak	<b>Art Unit</b> 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 11-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-10 and 20-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, of U.S. Patent No. 6,579,253 to Burbank et al in view of US 4,683,053 to Polaschegg. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented material comprises substantially all the limitations presented in the instant case.

For example, with regard to claims 1, 4, and 20, the '253 patent claims an extracorporeal circuit with a fluid circuit, blood treatment machine or filter, and the circuit being integrated within a first and second panel, wherein the panels carry incoming and outgoing fluids, and a cartridge orienting the panels as an integrated unit on a blood treatment machine (see claims 1-3 of the '253 patent). The '253 patent fails to claim that the blood treatment machine is configured to control the fluid flow to maintain an equal volume of incoming and outgoing fluids. Polaschegg discloses a blood treatment machine that controls a blood circuit and a diasylate circuit with a balancing device that maintains equal quantities of fluid flowing to and from the treatment device as well as controlling the blood circuit in order to allow for more precise control of ultrafiltration (see Polaschegg column 1, lines 38-48, 63-67, column 2, lines 4-14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a balancing device and control mechanisms as taught by Polaschegg

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to the blood treatment device claimed in the '253 patent, in order to more precisely control ultrafiltration, as taught by Polaschegg (see Polaschegg, column 1, lines 38-48).

With regard to claim 2, see claims 2-3 of the '253 patent.

With regard to claims 3 and 5, the '253 patent claims that the fluid cassette comprises two fluid circuits, both of which are incorporated "at least in part" (meaning, in part or in their entirety) in panels as an integrated unit on the fluid processing machine (see claim 1 of the '253 patent). Since the patent claims that the fluid paths are integrated within the panels, it flows naturally that the cartridge may comprise the entire fluid circuit, since the cartridge may be installed as an integrated unit on the blood processing machine. As such, the claim language of the '253 patent encompasses the limitations of instantly presented claim 3.

With regard to claims 6-10, see claims 4-8 of the '253 patent.

With regard to claim 21, see claim 31 of the '253 patent.

With regard to claims 22, 23 see claims 7, 2, and 3 of the '253 patent.

With regard to claim 24, see claim 24 of the '253 patent.

### ***Allowable Subject Matter***

3. Claims 1-10 and 20-24 would be allowable upon the submission of a Terminal Disclaimer referencing US 6,579,253 to Burbank as presented above.

4. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose or suggest the apparatus as claimed by applicant. In particular, the prior art fails to disclose or suggest an extracorporeal circuit with a

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blood circuit and a blood treatment machine wherein the circuit is integrated, at least in part, within a first and second panel sections and a fluid processing cartridge orienting the first and second panels for mounting as an integrated unit on a fluid processing machine in combination with the other elements (or steps) in the claims.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

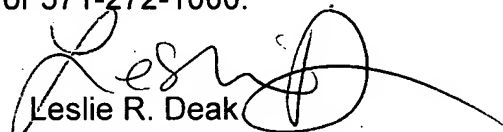
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie R. Deak whose telephone number is 571-272-4943. The examiner can normally be reached on M-F 7:30-5:00, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Leslie R. Deak  
Patent Examiner  
Art Unit 3761  
18 January 2007